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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,344	10/17/2003	Tatsuo Itabashi	9792909-5712	2279

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SONNENSCHN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

EXAMINER

COULTER, KENNETH R

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,344

Applicant(s)

ITABASHI ET AL.

Examiner

Kenneth R. Coulter

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 17-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/169,505.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/17/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. Applicant is requested to update the patent number information (U.S. Pat. No. regarding U.S. Serial No. 10/444,775 in the "RELATED APPLICATION DATA" section of the specification.

Claims 17 – 25 are objected to because of the following informalities: "connected to service provider device (claim 17, line 2). Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 17 – 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 teaches "reading **a manner of** using personal information" (claim 17, line 6).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 17 – 46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 10 of U.S. Patent No. 6,842,752; claims 17 – 46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 19 of U.S. Patent No. 6,601,092; claims 17 – 46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 24 of U.S. Patent No. 6,651,090; and claims 17 – 46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 72 of U.S. Patent No. 6,308,203. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present Application and the above relate U.S. Patents disclose:

Regarding claim 17, disclose an information processing method in an information processing apparatus connected to a service provider device and terminal device, comprising the steps of:

storing personal information of a user;

receiving a request to perform a transaction with said service provider device from said terminal device;

reading a *manner of using* personal information by said service provider device;

reading one or more items requested by the service provider device from said stored personal information; and

sending said manner and said one or more items requested by said service provider device.

Per claim 18, teach that said manner requires that said personal information is to be used only by the service provider device.

Regarding claim 19, disclose that said personal information is to be provided by the service provider to another service provider for use.

Per claim 20, teach that said terminal device comprises a wireless device comprising one of a PDA, a mobile telephone, a personal handyphone, a pager, a laptop computer and a handheld information processing device.

Regarding claim 21, disclose that said personal information comprises one or more of a user payment information, a user home address, a user e-mail address, a user telephone number, a user date of birth, a user age, a user gender, a user occupation, a user password, and a user ID.

Per claim 22, teach that said step of sending further sends a button for determining whether providing said one or more items to said service provider device or not.

Regarding claim 23, discloses that said button includes positive (yes) button of provision of personal information and negative (no) button of prohibition of personal information.

Per claim 24, teaches retrieving a reply from said user.

Regarding claim 25, discloses processing said transaction on the basis of said reply from said user.

Per claims 26 – 46, the discussion above applies fully.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 17 – 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Herz et al. (U.S. Pat. No. 5,754,938) (Pseudonymous Server for System for Customized Electronic Identification of Desirable Objects).

7.1 Regarding claim 17, Herz discloses an information processing method in an information processing apparatus connected to a service provider device and terminal device, comprising the steps of:

storing personal information of a user (Fig. 2; col. 34, lines 39 – 43; col. 45, lines 41 – 48 “database”);

receiving a request to perform a transaction with said service provider device from said terminal device (col. 45, lines 35 – 39 “The general solution to this problem is for proxy server S2 to act as a representative on behalf of each user in its user base, **permitting access to the user and the user’s private data only in accordance with criteria that have set by the user**”);

reading *a manner of using* personal information by said service provider device (Abstract; col. 45, lines 35 - 39);

reading one or more items requested by the service provider device from said stored personal information (Abstract; col. 45, lines 35 - 39); and

sending said manner and said one or more items requested by said service provider device (Abstract; col. 45, lines 35 - 39).

7.2 Per claim 18, Herz teaches that said manner requires that said personal information is to be used only by the service provider device (col. 45, lines 35 – 39 “The general solution to this problem is for proxy server S2 to act as a representative on behalf of each user in its user base, **permitting access to the user and the user’s private data only in accordance with criteria that have set by the user**”).

7.3 Regarding claim 19, Herz discloses that said personal information is to be provided by the service provider to another service provider for use (col. 32, lines 51 - 65).

7.4 Per claim 20, Herz teaches that said terminal device comprises a wireless device comprising one of a PDA, a mobile telephone, a personal handyphone, a pager, a laptop computer and a handheld information processing device (Fig. 2, items C1-Cn; col. 30, lines 35 – 39 “Clients C1-Cn are not necessarily continuously online, since they typically serve a single user and can be **movable systems, such as laptop** computers ...”).

7.5 Regarding claim 21, Herz discloses that said personal information comprises one or more of a user payment information (col. 31, lines 25 - 31), a user home address

(Abstract), a user email address (Abstract; col. 29, lines 8 – 10), a user telephone number (Abstract “giving the user control over the ability of third parties to access this summary and to identify or **contact** the user”), a user date of birth (Abstract), a user password (col. 29, lines 11 – 14; col. 30, lines 39 - 43), and a user ID (Abstract).

7.6 Per claims 22 and 23, Herz does not explicitly teach that said step of sending further *sends* a button for determining whether providing said one or more items to said service provider device or not; or

that said button includes positive (yes) button of provision of personal information and negative (no) button of prohibition of personal information.

However, these are commonplace, inherent gui features than would enable a user of the system of Herz to select privacy or not.

7.7 Per claim 24, Herz teaches retrieving a reply from said user (col. 45, lines 35 - 39).

7.8 Regarding claim 25, Herz discloses processing said transaction on the basis of said reply from said user (col. 45, lines 35 - 39).

7.9 Per claims 26 – 46, the rejection of claims 17 – 25 under 35 USC 102(e) (paragraphs 7.1 – 7.8 above) applies fully.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

krc

KENNETH R. COULTER
PRIMARY EXAMINER
